

REMARKS

Claims 12, 14, and 16 to 28 are pending in the application.

Claim 17 is currently amended.

Claims 12, 14, and 16, and 18 to 28 were previously presented.

Claim 17 is currently amended to delete the definition of the term, "5-membered heteroarylenyl." The definition is unnecessary in view of the absence of group "V" in claim 17.

Election/Restrictions

Applicants note that in the present Office Action, the restriction requirement made previously in the Office Action mailed September 16, 2005, has been amended to correctly recite claims 12, 14, and 16 to 28, which were the claims that were pending when the restriction requirement was made. As noted in the Office Action, Applicants have already elected the invention of Group II:

claims 12, 14, and 16 to 28, drawn to a compound of formula I, wherein group S is N and T, U, and W are each C-R⁴, or a compound of formula II, wherein one of S, T, and U is N and the other two of S, T, and U are each C-R⁴, namely a pyridine-core compound, composition, and method of use, which are classified in classes 546 and others, subclasses 268.1, 290, 291, 297, 298, and various others, class 514, subclasses 336, 345, 346, and various others depending upon the choice of preferred embodiments of group V of formula I and the other variable groups of formula I and II.

Applicants note that their previous election of the invention of Group II and species of Example F9 was made in their reply mailed October 13, 2005, and received by the USPTO on October 17, 2005.

Information Disclosure Statement

Applicants note that the information disclosure statements (IDSs) received March 8, 2004, and July 20, October 17, and December 9, 2005, have been made of record. However, Applicants note that the Office Action mailed June 16, 2003, in United States Patent Application No. 10/264,764 (Office Action of 10/264,764) that was cited in the IDS received July 20, 2005, was not made of record because it was alleged that it is not a publication *per se*.

Applicants respectfully traverse the objection to making the Office Action of 10/264,764 of record in the present application. The rules relating to submission of information in an IDS are found in 37 C.F.R. §§ 1.97-1.98. In these rules, there is no prohibition against submitting items that are not publications *per se*. To the contrary, Rule 1.98(a)(2)(iv) mentions that "All other information or that portion which caused it to be listed" may properly be included in an IDS. Further, in the present case, the Office Action of 10/264,764 is published on Public Pair (see the following link: http://portal.uspto.gov/external/portal/!ut/p/s.7_0_A/7_0_CH/.cmd/ad/.ar/sa.getBib/.c/6_0_69/.ce/7_0_1ET/.p/5_0_18L/.d/1?selectedTab=ifwtab&isSubmitted=isSubmitted&dosnum=10264764). Accordingly, Applicants request that the Office Action of 10/264,764, be made of record in the present case.

In view of the above remarks and to facilitate consideration of the Office Action of 10/264,764, Applicants submit with this paper a new information disclosure statement under 37 CFR §§ 1.97-1.98 on form PTO/SB/08B that cites the Office Action of 10/264,764. Because the cited office action was previously submitted in an IDS now of record, Applicants believe no fee is required. If a fee is required, the Commissioner is hereby authorized to charge any fees that may be required, or credit any overpayment, to deposit account number 23-0455.

Applicants respectfully request that the Examiner consider carefully the complete text of the cited office action in connection with examination of the above-identified application in accord with 37 CFR §1.104(a). It is respectfully requested that all cited reference(s) considered by the Examiner be listed in the "References Cited" portion of any patent issuing from the instant application (MPEP § 1302.12).

Claim Rejections – 35 U.S.C. § 112, Second Paragraph

In the Office Action, claims 19, 20, and 26-28 are rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It was stated that recitation of the phrase "any one of claims 17 and 21" renders claims 26-28 vague and unclear. In the Office Action, it was stated that Markush choices should be in alternate form. Further, it was alleged that claims 19 and 20 are indefinite because it is not clear what variable group is being recited therein in the absence of a label or reference to a variable group of formula II.

Applicants traverse the rejection for the reasons provided below.

Claims 26-28 recite the phrase, “according to any one of claims 17 and 21.” This phrasing is analogous to the phrase, “as in any one of claims 1, 2, and 3,” which is used to exemplify acceptable multiple dependent claim wording in the MPEP at § 608.01(n)(I)(A) on page 600-75 (third example). Accordingly, Applicants believe that the objected to phrase is in alternate form and that claims 26-28 are definite and patentable under 35 U.S.C. § 112, second paragraph.

Claim 19 depends from independent claim 17 through intervening dependent claim 18. Claim 19 recites the phrase, “wherein each C₁-C₆ alkylenyl is CH₂.” Applicants believe this phrase is clear because there is antecedent basis for the group “C₁-C₆ alkylenyl” in claims 17 and 18 and the meaning of “each” is unambiguous. Thus in claim 19, each “C₁-C₆ alkylenyl” recited in claims 17 and 18 is further defined as being “CH₂.” Accordingly, Applicants believe that claim 19 is definite and patentable under 35 U.S.C. § 112, second paragraph.

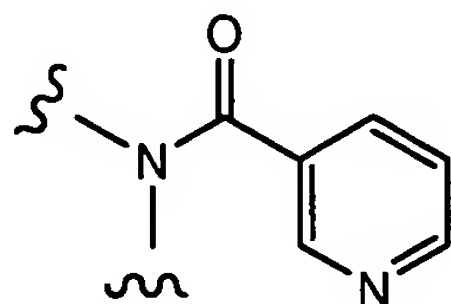
Claim 20 depends from independent claim 17 through intervening dependent claims 18 and 19. Claim 20 recites the unambiguous phrase, “wherein at least one substituent is selected from the group consisting of [*choices omitted here for brevity*].” The term “substituent” has antecedent basis in claim 17, for example, in the definition of substituents at the top of page 6 of this paper (“Each ‘substituted’ group contains from 1 to 4 substituents” – underlining added for emphasis). Thus in claim 20, each substituent recited in claims 17-19 is further defined as being selected from the group consisting of the choices defined in claim 20. Applicants believe that no further label or reference to a variable group of formula II is necessary in claim 20. Accordingly, Applicants believe that claim 20 is definite and patentable under 35 U.S.C. § 112, second paragraph.

Claim Rejections – 35 U.S.C. § 102

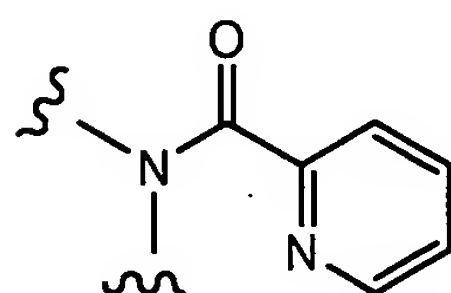
In the Office Action, claim 21 is rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by Riordan et al., U.S. Patent No. 5,756,524 (Riordan et al. patent). Particularly, see example compounds 37, 148, and 155.

Applicants traverse the rejection because the compounds of the Riordan et al. patent are outside the scope of instant claim 21. Example compounds 37, 148, and 155 of the Riordan et al. patent each have an amide carbonyl carbon bonded to the 3-position

of a pyridyl moiety, whereas the carbonyl carbon of group Q of the compound of instant claim 21 is bonded to the 2-position of a pyridyl moiety (S is N in instant claim 21). The below structures illustrate these binding differences:



a 3-pyridyl carboxamide



a 2-pyridyl carboxamide

Further, Applicants note that in the Riordan et al. patent, example compounds 43, 62, 73, 103, 120, 121, 125, and 159 are recited as “2-pyridyl” containing compounds, but these 2-pyridyls are not substituted by the 5-membered heteroarylenyl group “V” of instant claim 21. Applicants believe that the compounds of the Riordan et al. patent do not contain all of the elements of the compound of instant claim 21. Accordingly, the Riordan et al. patent does not anticipate instant claim 21 and instant claim 21 is patentable under 35 U.S.C. 102(b) over the Riordan et al. patent.

In the Office Action, claims 21 and 26 are rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by Strobel, et al., European Patent Application Publication No. EP 1388341A1 (EP 1388341A1). Applicants traverse the rejection because EP 1388341A1 is not an “international application” for the purposes of § 102(e). In section 102(e), international applications are only those that are filed under the treaty defined in 35 U.S.C. § 351(a), which defines the treaty as being the Patent Cooperation Treaty (PCT). EP 1388341A1 is not a PCT international application. Accordingly, EP 1388341A1 is not a proper reference under § 102(e) and claims 21 and 26 are patentable under 35 U.S.C. § 102(e) over EP 1388341A1.

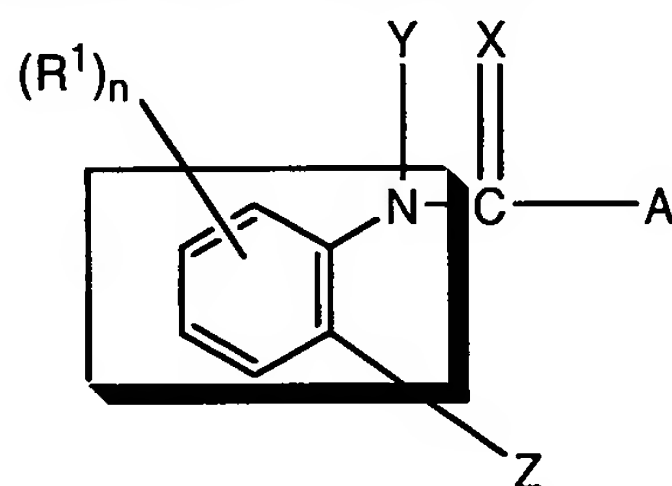
Claim Rejections – 35 U.S.C. § 103

In the Office Action, claims 17-25 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Riordan et al., which was also cited in the above-referenced rejection under § 102(b). It was stated in the Office Action that the Riordan et

al. patent teaches several anilide derivatives as fungicides, and that these derivatives include compounds in the instant claim[s].

Applicants traverse the rejection for the reasons provided below.

The Riordan et al. patent teaches that the compound of formula (I) of the Riordan et al. patent is always a substituted anilide, wherein the anilide moiety is highlighted below in a redrawing (for illustration) of formula (I):



(I) of the Riordan et al. patent

wherein A, X, Y, Z, R¹, and n are as defined therein. The (R¹)_n(Z)phenyl- moiety of the compound of formula (I) of the Riordan et al. patent is bonded to the nitrogen atom in formula (I). The anilide derivatives of formula (I) were selected by Riordan et al. for their fungicidal activity. Thus, the highlighted anilide portion of the compound of formula (I) apparently is critical to the fungicidal activity of the invention of the Riordan et al. patent. Further, Applicants believe that the A group cannot comprise an unsubstituted or substituted C₃-C₆ cycloalkyl-(C₁-C₆ alkylenyl) group; see, for example, the definition of substituted alkyl in column 2, at lines 12-17.

Regarding claims 17-20 and 23-25, at least one of R¹ and R² is a C₃-C₆ cycloalkyl-(C₁-C₆ alkylenyl) or substituted C₃-C₆ cycloalkyl-(C₁-C₆ alkylenyl) group. Applicants believe that there is no teaching or suggestion in the Riordan et al. patent to modify the compounds of Riordan et al. patent to arrive at the compounds of instant claims 17-20 having at least one of R¹ and R² that is independently selected from:

- C₃-C₆ cycloalkyl-(C₁-C₆ alkylenyl); and
- Substituted C₃-C₆ cycloalkyl-(C₁-C₆ alkylenyl).

Further, regarding the present claims 17-25, instant R¹ is bonded to the nitrogen atom of group Q. In present claims 17-25, the definition of R¹ includes the groups:

- C₃-C₆ cycloalkyl-(C₁-C₆ alkylenyl); Substituted C₃-C₆ cycloalkyl-(C₁-C₆ alkylenyl); H; C₁-C₆ alkyl; Substituted C₁-C₆ alkyl; C₂-C₆ alkenyl;

Substituted C₂-C₆ alkenyl; C₂-C₆ alkynyl; Substituted C₂-C₆ alkynyl; C₃-C₆ cycloalkyl; Substituted C₃-C₆ cycloalkyl; C₃-C₆ cycloalkyl-(C₁-C₆ alkylenyl); Substituted C₃-C₆ cycloalkyl-(C₁-C₆ alkylenyl); 3- to 6-membered heterocycloalkyl; Substituted 3- to 6-membered heterocycloalkyl; 3- to 6-membered heterocycloalkyl-(C₁-C₆ alkylenyl); Substituted 3- to 6-membered heterocycloalkyl-(C₁-C₆ alkylenyl); Phenyl-(C₁-C₆ alkylenyl); Substituted phenyl-(C₁-C₆ alkylenyl); Naphthyl-(C₁-C₆ alkylenyl); Substituted naphthyl-(C₁-C₆ alkylenyl); 5-, 6-, 9-, and 10-membered heteroaryl-(C₁-C₆ alkylenyl); Substituted 5-, 6-, 9-, and 10-membered heteroaryl-(C₁-C₆ alkylenyl); Phenyl; Substituted phenyl; Naphthyl; Substituted naphthyl; 5-, 6-, 9-, and 10-membered heteroaryl; Substituted 5-, 6-, 9-, and 10-membered heteroaryl; R³O-(C₁-C₆ alkylenyl); Substituted R³O-(C₁-C₆ alkylenyl); Phenyl; Substituted phenyl; Naphthyl; Substituted naphthyl; 5- or 6-membered heteroaryl; Substituted 5- or 6-membered heteroaryl; 8- to 10-membered heterobiaryl; Substituted 8- to 10-membered heterobiaryl; Phenyl-O-(C₁-C₈ alkylenyl); Substituted phenyl-O-(C₁-C₈ alkylenyl); Phenyl-S-(C₁-C₈ alkylenyl); Substituted phenyl-S-(C₁-C₈ alkylenyl); Phenyl-S(O)-(C₁-C₈ alkylenyl); Substituted phenyl-S(O)-(C₁-C₈ alkylenyl); Phenyl-S(O)₂-(C₁-C₈ alkylenyl); and Substituted phenyl-S(O)₂-(C₁-C₈ alkylenyl), wherein R¹ and R² are not both selected from: H; C₁-C₆ alkyl; C₂-C₆ alkenyl; C₂-C₆ alkynyl; and C₃-C₆ cycloalkyl, and wherein R¹ and R³ are as defined in claims 17-25, respectively.

The compounds of the Riordan et al. patent require the highlighted anilide moiety, and thus the anilide moiety apparently was critical for the fungicidal activity of the compound of reference formula (I). Accordingly, one of ordinary skill in the art would not have been motivated by the Riordan et al. patent to modify the compounds of reference formula (I) to arrive at the compounds of instant claims 17-20 or 21-25. When viewed "as a whole" and in view of the above remarks, Applicants believe that claims 17-25 are nonobvious and patentable under 35 U.S.C. § 103(a) over the Riordan et al. patent.

In the Office Action, claims 21 and 26 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Strobel, et al., European Patent Application Publication No. EP 1388341A1 (EP 1388341A1), which was also cited in the above-referenced rejection under § 102(e). Applicants traverse the rejection because EP 1388341A1 is not

a proper reference under § 103(a)/102(e) for the reasons provided above and otherwise is not a proper reference under § 103(a) since it published on February 11, 2004, which is after the filing date of August 5, 2003, and priority date of August 13, 2002, of the present application.

Conclusion

Applicants note that in the Office Action, claims 12, 14, and 16 are allowed. In view of the above remarks, Applicants believe that the rejections are overcome and request reconsideration of claims 17-28.

Respectfully submitted,

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